REMARKS

By this Reply, Applicants cancel claims 69 and 70, without prejudice or disclaimer of the subject matter therein, amend claims 1, 30-33, 35, 54, 63, 65-68 and 72, and add new claims 85 and 86. Claims 1-68 and 71-86 are therefore pending in this application, with claims 1, 54, 63 and 72 being independent. Support for the claim amendments and new claims can be found throughout Applicants' disclosure.

In the final Office Action of September 6, 2007 ("Office Action"), claims 21 and 52 were rejected under 35 U.S.C. § 112, second paragraph; claims 1-4, 7, 8, 18-32, 35-43, 47-55, 57, 58, 60-64, 66, 67 and 69-84 were rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 5,880,731 ("*Liles*") and U.S. Patent No. 6,349,327 ("*Tang*"); claims 5, 6, 9-17, 56, 59, 65 and 68 were rejected under section 103(a) based on *Liles*, *Tang* and WO 01/84461 A1 ("*Kim*"); claims 33 and 34 were rejected under section 103(a) based on *Liles*, *Tang* and U.S. Patent No. 7,007,065 ("*Matsuda*"); and claims 44-46 were rejected under section 103(a) based on *Liles*, *Tang* and U.S. Patent No. 7,177,811 ("*Ostermann*"). These rejections and the new claims are addressed below.

Section 112 rejection

The Office Action asserts that claims 21 and 52 are indefinite because of the term "substantially" recited in the claims. *See* Office Action, p. 2. According to the Office Action, the term is not defined in the claim, the specification does not provide a standard, and one of ordinary skill would not be reasonably apprised of the scope of the claim. *See id.* Applicants traverse the section 112 rejection for the following reasons.

According to section 2173.02 of the M.P.E.P., "[t]he essential inquiry pertaining to this requirement [of definiteness] is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity." M.P.E.P. § 2173.05(b) states:

> The fact that claim language, including terms of degree, may not
> be precise, does not automatically render the claim indefinite under
> 35 U.S.C. 112, second paragraph (internal citations omitted).
> Acceptability of the claim language depends on whether one of
> ordinary skill in the art would understand what is claimed, in light
> of the specification.

Applicants : Patrick D. Blattner et al.   Attorney's Docket No.: 06975-467001 / AOL 213
App. No. : 10/747,652
Filed   : December 30, 2003
Page   : 16 of 27

As noted in the M.P.E.P., the Federal Circuit held that "the limitation 'which produces substantially equal E and H plane illumination patterns' was definite because one of ordinary skill in the art would know what was meant by 'substantially equal.'" M.P.E.P. § 2173.05(b), 8th Ed., Rev. 6 (September 2007) (quoting *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988)).

In this case, the recitation in claim 21 of an activity that is performed "at substantially the same time that the out-of-band message is communicated" is definite. Likewise, the recitation in claim 52 of "a depiction of the avatar in the form that is substantially similar to a trading card" is definite under section 112.

Applicants submit that one of ordinary skill in the art would be able to ascertain the meaning of "substantially" in claims 21 and 52 from the claim language itself in light of the specification, irrespective of whether a standard or definition is explicitly stated in the specification or the claim. *See* M.P.E.P. § 2173.02 and § 2173.05(b). As with the recitation of "substantially equal," one of ordinary skill in the relevant art would understand the meaning of the terms "substantially the same time" and "substantially similar." *See* M.P.E.P. § 2173.05(b).

The Office Action asserts that "substantially the same time" could mean "exactly the same time or a 10 [minute] . . . delay." Office Action, pp. 2, 15. Applicants submit that a skilled artisan would understand what is meant by "substantially the same time" in claim 21. The term "substantially the same" has a well-recognized and discernible meaning, and the Office Action offers no evidence or explanation, beyond conjecture, to show why one of ordinary skill in the art would not be reasonably apprised of its meaning. *See* M.P.E.P. § 2173.02. Even if "substantially the same time" were construed to include a 10 minute delay, the Office Action offers no explanation as to why this term would be indefinite.

Applicants submit that claims 21 and 52 are fully compliant with section 112, second paragraph, and thus respectfully request withdrawal of the rejection.

Section 103 rejection based on *Liles* and *Tang*

The section 103 rejection of claims 69 and 70 is rendered moot by the cancellation of those claims. The section 103 rejection of claims 1-4, 7, 8, 18-32, 35-43, 47-55, 57, 58, 60-64,

66-67 and 71-84 should be withdrawn because *Liles* and *Tang* fail to support a conclusion of obviousness with respect to Applicants' claims, as now amended.

Amended independent claim 1 recites a combination including:

> receiving, <u>independently of the first user and the message,</u> out-of-band information indicating a context of the first user; and

> communicating, based on stored data associations, the out-of-band information to the second user by <u>changing an animation of the avatar representing the first user to graphically convey the context of the first user indicated by the received out-of-band information.</u>

Liles does not disclose or suggest the combination recited in claim 1, including at least the "receiving" and "communicating" features noted above.

Liles is directed to animating avatars. *See* Abstract. *Liles* discloses that a user can select an animation of an avatar that conveys a desired emotion and/or state of mind to another user in a chat session. *See* col. 3, lines 28-42. *Liles* discloses that a selected animation can be selectively displayed in combination with a textual message transmitted by the participant. *See* col. 3, lines 32-41. *Liles* also describes that a user can select avatar animations that convey gestures (e.g., checking a watch) for display to other users in a chat session. *See* col. 7, lines 18-42; col. 9, lines 55-65.

Liles nowhere discloses or suggests receiving, <u>independently of the first user and the message,</u> out-of-band information related to a context of the first user and communicating, based on stored data associations, the out-of-band information to the second user by <u>changing an animation of the avatar representing the first user to graphically convey the context of the first user indicated by the received out-of-band information,</u> as claimed. Instead, *Liles*'s system merely allows a user to select an avatar animation, for example, from a gesture toolbar. *See* col. 9, lines 33-38; Fig. 7. *Liles* fails to disclose or suggest changing an animation of avatar to graphically convey a context of a user, where the context is received independently of the user and the message. *Liles* further fails to disclose or suggest any stored data associations serving as a basis for changing the avatar animation, as claimed.

Tang fails to cure *Liles*'s deficiencies. *Tang* discloses a mechanism for enabling users to "know which other users are 'nearby' in terms of the type of work they are doing." Col. 3, lines

31-42. *Tang*'s system provides a visual/aural cue of this "task proximity" using an icon (22) appearing in an "encounter window" (20) of a user interface. Col. 5, lines 3-11; *see* Fig. 1. *Tang*'s encounter window is periodically updated as workers become task proximate to the current worker and as workers lose their task proximity. *See* col. 4, lines 64-66. In particular, when a worker becomes task proximate or loses task proximity, the encounter window adds or remove an icon to indicate the proximity status. *See* col. 5, lines 3-11.

In *Tang*'s system, the addition or removal of icons can involve a "visual transformation" of icons, which may include "a fade, wipe, dissolve, pull, or other gradual visual effects that place and remove the icons 22." Col. 7, lines 55-65. Additionally, degrees of task proximity can be indicated by "different color borders on the icons 22, different border patterns, or positioning of the icons 22, or other visual attributes." Col. 9, lines 58-61. *Tang* provides the example of placing icons for more task proximate workers at the top of the encounter window and placing icons for less task proximate workers at the bottom. *See* col. 9, lines 61-65.

Although *Tang* discloses providing a visual/aural cue of task proximity, the reference does not disclose or suggest at least communicating, based on stored data associations, out-of-band information by changing an animation of the avatar representing the first user to graphically convey the context of the first user indicated by the received out-of-band information, as claimed. Even if *Tang*'s "task proximity" information were construed as "out-of-band information," *Tang* still fails to disclose or suggest changing an animation of an avatar to graphically convey the context of a user, as claimed.

Indeed, *Tang* does not disclose or suggest changing an animation of the icon (22) to graphically convey the context of a user. *Tang* discloses a "visual transformation" of icons, which may include "a fade, wipe, dissolve, pull, or other gradual visual effects that place and remove the icons 22." Col. 7, lines 55-65. Such adding and removing of icons, however, does not constitute changing an animation of an avatar, as required by claim 1. Furthermore, indicating degrees of proximity using "different color borders on the icons 22, different border patterns, or positioning of the icons 22, or other visual attributes," as described by *Tang*, does not constitute changing an animation of an avatar. Although *Tang*'s system might change "visual attributes" of an icon, there is no indication of changing an animation of an icon.

Applicants : Patrick D. Blattner et al.   Attorney's Docket No.: 06975-467001 / AOL 213
App. No. : 10/747,652
Filed   : December 30, 2003
Page   : 19 of 27

For at least the foregoing reasons, *Liles* and *Tang*—whether taken alone or in any combination—fail to disclose or suggest each and every feature of claim 1. Moreover, no basis has been established for "concluding that it would have been obvious to one of ordinary skill in the art to bridge the gap." M.P.E.P. § 2143.01 (VI), 8th Ed., Rev. 6 (September 2007). Indeed, the applied references do not provide such a basis. The section 103 rejection of claim 1 should accordingly be withdrawn. The section 103 rejection of dependent claims 2-4, 7, 8, 18-32, 35-43, 47-53 and 76-78 should be withdrawn as well, for at least reasons similar to those presented above in connection with claim 1.

Moreover, dependent claim 7 recites a combination including receiving, independently of the first user and the message, out-of-band information related to a context of the first user, where the out-of-band information comprises information indicating a <u>personality characteristic</u> associated with the first user. *Liles* and *Tang* do not support a conclusion of obviousness with respect to these additional features of claim 7.

In rejecting claim 7, the Office Action cites to *Liles*'s disclosure of a character selection dialog box that enables a user to select an avatar for represent the user in an on-line chat. *See* Office Action, p. 5. Even if the character selection disclosed by *Liles* were construed as information indicating a "personality characteristic," *Liles* still fails to disclose or suggest the "receiving" feature of claim 7. Indeed, the out-of-band information indicating a personality characteristic recited in dependent claim 7 corresponds to the out-of-band information recited in claim 1 and therefore is received "independently of the first user and the message," as recited in claim 1. *Liles* does not disclose or suggest receiving a character selection "independently of the first user and the message," as claimed.

Tang, like *Liles*, fails to disclose or suggest receiving, independently of the first user and the message, information indicating a <u>personality characteristic</u> associated with the first user, as required by dependent claim 7. *Tang* merely discloses providing an indication of "which other users are 'nearby' in terms of the type of work they are doing." *Tang*'s "task proximity" information does not constitute information indicating a <u>personality characteristic</u>, as recited in dependent claim 7.

The Advisory Action asserts that "Tang teaches receiving, independently of the first user and the message, . . . and Liles teaches information indicating a personality characteristic

associated with the first user." Advisory Action, p. 2. This assertion in the Advisory Action does not support a conclusion of obviousness. In particular, as M.P.E.P. § 2141.02(I) makes clear, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02 (I) (internal citations omitted). Although *Liles* and *Tang* might individually disclose certain subject features of claim 7, neither of these references discloses or suggests the "receiving" feature of claim 7 taken as a whole. That is, neither *Liles* nor *Tang* discloses or suggests receiving, independently of the first user and the message, information indicating a personality characteristic associated with the first user.

Additionally, no basis has been established on the record for concluding that it would have been obvious to one of ordinary skill in the art to modify or combine *Liles* and *Tang* to achieve what is recited in claim 7. That each of the applied references might disclose a piece of the "receiving" feature does not by itself establish that the "receiving" feature as a whole would have been obvious.

Dependent claim 8 recites, *inter alia*, receiving, independently of the first user and the message, out-of-band information related to a context of the first user, where the out-of-band information comprises information indicating an emotional state associated with the first user. *Liles* and *Tang* do not support a conclusion of obviousness with respect to these additional features of claim 8.

In rejecting claim 8, the Office Action cites to *Liles*'s disclosure regarding a user selecting an avatar gesture that conveys a personality trait and/or an emotion. *See* Office Action, p. 5. Although *Liles* discloses personality traits and emotions, the reference still fails to disclose or suggest the "receiving" feature of claim 8. In particular, *Liles* does not disclose or suggest receiving information indicating an emotional state "independently of the first user and the message," as required by claim 8. *Liles* merely discloses a user selecting a gesture.

Tang, like *Liles*, fails to disclose or suggest receiving, independently of the first user and the message, information indicating an emotional state associated with the first user, as required by dependent claim 8. *Tang*'s "task proximity" information—which indicates "which other

users are 'nearby' in terms of the type of work they are doing"—does not constitute information indicating an <u>emotional state</u>, as recited in claim 8.

The Advisory Action asserts that "Tang teaches receiving, independently of the first user and the message, . . . out-of-band information . . . and Liles teaches information indicating an emotional state associated with the first user." Advisory Action, p. 2. This assertion in the Advisory Action does not support a conclusion of obviousness. Although *Liles* and *Tang* might individually disclose certain subject features of claim 8, neither of these references discloses or suggests the "receiving" feature of claim 8 taken as a whole. Furthermore, no basis has been established on the record for concluding that it would have been obvious to one of ordinary skill in the art to modify or combine *Liles* and *Tang* to achieve what is recited in claim 8.

Dependent claim 18 recites receiving, independently of the first user and the message, out-of-band information related to a context of the first user, where out-of-band information comprises information related to <u>a mood</u> of the first user. *Liles* and *Tang* do not support a conclusion of obviousness with respect to these additional features of claim 18.

In rejecting claim 18, the Office Action cites again to *Liles*'s disclosure regarding a user selecting an avatar gesture that conveys a personality trait and/or an emotion. *See* Office Action, p. 5. Even if *Liles* were to disclose information related to a user mood, the reference still fails to disclose or suggest the "receiving" feature of claim 18. Indeed, *Liles* does not disclose or suggest receiving information related to a mood of the user "independently of the first user and the message," as required by Applicants' claim.

Tang also fails to disclose or suggest receiving, independently of the first user and the message, information related to <u>a mood</u> of the first user, as recited in claim 18. *Tang*'s "task proximity" information does not constitute information related to <u>a mood</u> of the user, as recited in claim 18.

The Advisory Action asserts that "Tang teaches receiving, independently of the first user and the message, out-of-band information . . . and Liles teaches information related to a mood of the first user." Advisory Action, p. 2. This assertion in the Advisory Action does not support a conclusion of obviousness. Although *Liles* and *Tang* might individually disclose certain subject features of claim 18, neither of these references discloses or suggests the "receiving" feature of claim 18 taken as a whole. Moreover, no basis has been established on the record for concluding

that it would have been obvious to one of ordinary skill in the art to modify or combine *Liles* and *Tang* to achieve what is recited in claim 18.

For at least these additional reasons noted above, a case for obviousness has not been established with respect to dependent claims 7, 8 and 18. The section 103 rejection of dependent claims 7, 8 and 18 should accordingly be withdrawn.

Similar to claim 1, amended independent claim 54 recites a combination including:

> receive, <u>independently of the first user and the message</u>, out-of-band information indicating a context of the first user; and
>
> communicate, based on stored data associations, the out-of-band information to the second user by <u>changing an animation of the avatar representing the first user to graphically convey the context of the first user indicated by the received out-of-band information</u>.

Although claims 1 and 54 are different in scope, the section 102 rejection of claim 54 based on *Liles* and *Tang* should be withdrawn for at least reasons similar to those presented above in connection with claim 1. The section 103 rejection of claims 55, 57, 58 and 60-62 should likewise be withdrawn, since these claims depend upon claim 54.

Furthermore, each of dependent claims 57, 58 and 60 recites subject matter similar to that recited in one of dependent claims 7, 8 and 18. For at least reasons similar to the additional reasons presented above in connection with claims 7, 8 and 18, the section 103 rejection of claims 57, 58 and 60 should be withdrawn.

Amended independent claim 63 recites a combination including:

> receive, <u>independently of the first user and the message</u>, out-of-band information indicating an activity of the first user; and
>
> communicate, based on stored data associations, the out-of-band information to the second user by <u>animating the avatar to graphically perform the activity of the first user indicated by the received out-of-band information</u>.

Liles does not disclose or suggest the combination recited in claim 63, including at least the "receive" and "communicate" features noted above. *Liles*'s system merely allows a user to select an avatar animation, for example, from a gesture toolbar. *Liles* does not disclose or suggest animating an avatar to graphically perform an activity of a user, where the activity is

Applicants : Patrick D. Blattner et al.   Attorney's Docket No.: 06975-467001 / AOL 213
App. No. : 10/747,652
Filed   : December 30, 2003
Page   : 23 of 27

indicated by information received independently of the user and the message. *Liles* further fails to disclose or suggest any stored data associations serving as a basis for such animating, as claimed.

      Tang fails to cure *Liles*'s deficiencies. *Tang* merely discloses indicating "task proximity" of users by way of icons. The reference does not disclose <u>animating an avatar to graphically perform an activity of a user indicated by received out-of-band information</u>, as claimed. Indeed, *Tang*'s "visual transformation" of icons, which may include "a fade, wipe, dissolve, pull, or other gradual visual effects that place and remove the icons 22," does not constitute animating an avatar to graphically perform an activity of a user indicated by received out-of-band information, as required by claim 63. Col. 7, lines 55-65. Likewise, indicating degrees of proximity using "different color borders on the icons 22, different border patterns, or positioning of the icons 22, or other visual attributes," as described by *Tang*, does not constitute animating an avatar to graphically perform an activity of a user, as claimed.

      Fig. 1 of the *Tang* shows an avatar with an indication of "attentive." Even if this "attentiveness" were considered an activity, there is no indication in the reference of <u>animating</u> the avatar to graphically perform such attentiveness. For example, the avatar is not <u>animated</u> such that the avatar acts attentive.

      Tang further discloses determining levels of availability by monitoring certain user activity, such as keyboard activity. *See* col. 10, line 63 – col. 11, line 15. *Tang* does not disclose, however, animating an avatar to perform any such monitored activity. Indeed, *Tang* does not disclose animating an avatar so that that avatar is typing on a keyboard. *Tang*'s monitored activity is merely used to determine a level of availability. Although *Tang* describes icons that indicate levels of availability, the reference does not disclose or suggest animating such icons to perform a monitored activity. *See* col. 11, lines 1-4.

      For at least the foregoing reasons, *Liles* and *Tang*—whether taken alone or in any combination—fail to disclose or suggest each and every feature of claim 63. Moreover, no basis has been established on the record for concluding that it would have been obvious to one of ordinary skill in the art to modify or combine *Liles* and *Tang* to achieve what is recited in amended independent claim 63. The section 103 rejection of claim 63 should accordingly be withdrawn.

Amended independent claim 72 recites, *inter alia*:

> means for receiving, <u>independently of the first user and the message</u>, out-of-band information indicating an activity of the first user; and

> means for communicating, based on stored data associations, the out-of-band information to the second user by <u>animating the avatar to graphically perform the activity of the first user indicated by the received out-of-band information</u>.

Although claims 63 and 72 are different in scope, the section 103 rejection of claim 72 based on *Liles* and *Tang* should be withdrawn for at least reasons similar to those presented above in connection with claim 63. The section 103 rejection of claims 64, 66, 67, 71-75 and 79-84 should likewise be withdrawn, since each of these claims depends upon one of claims 63 and 72.

Applicants accordingly request withdrawal of the section 103 rejection and the timely allowance of claims 1-4, 7, 8, 18-32, 35-43, 47-55, 57, 58, 60-64, 66-67 and 71-84.

Section 103 rejection based on *Liles, Tang* and *Kim*

Each of claims 5, 6, 9-17, 56, 59, 65 and 68 depends upon claim 1, 54 or 63. As discussed above, *Liles* and *Tang* fail to disclose or suggest each and every feature of claims 1, 54 and 63. *Kim* relates to changing a screen image containing an avatar acting in a virtual space and a background image. *See* Abstract. *Kim* describes determining a user's location, retrieving a predefined screen image based on the location, and transmitting the screen image to a client device for display to the user and modification by the user. *See* page 5; *see also* Fig. 2.

Kim fails to cure the deficiencies of *Liles* and *Tang* with respect to independent claims 1, 54 and 63, and no basis has been established for concluding that it would have been obvious to a skilled artisan to bridge the gap between the applied references and Applicants' claims. Accordingly, *Liles, Tang* and *Kim*—whether taken alone or in any combination—fail to render obvious claim 1, 54 or 63 or any of their respective dependent claims 5, 6, 9-17, 56, 59, 65 and 68. Applicants therefore request withdrawal of the section 103 rejection and the timely allowance of dependent claims 5, 6, 9-17, 56, 59, 65 and 68.

Section 103 rejection based on *Liles, Tang* and *Matsuda*

Claims 33 and 34 depend upon claim 1. As discussed above, *Liles* and *Tang* fail to disclose or suggest each and every feature of claim 1. *Matsuda* discloses a system that converts character data constituting a chat into audio data, which is output as a voice of an avatar. *See* Abstract; col. 1, lines 5-12; col. 10, lines 10-12. *Matsuda* does not cure the deficiencies of *Liles* and *Tang* with respect to independent claim 1, and no basis has been established for concluding that it would have been obvious to a skilled artisan to bridge the gap between the applied references and Applicants' claims. Accordingly, *Liles, Tang* and *Matsuda*—whether taken alone or in any combination—fail to render obvious claim 1 or its dependent claims 33 and 34. Applicants therefore request withdrawal of the section 103 rejection and the timely allowance of dependent claims 33 and 34.

Section 103 rejection based on *Liles, Tang* and *Ostermann*

Claims 44-46 depend upon claim 1. As discussed above, *Liles* and *Tang* fail to disclose or suggest each and every feature of claim 1. *Ostermann* relates to customizing multi-media messages. *See* Abstract; col. 1, lines 35-42. As noted in the Office Action, *Ostermann* describes accessorizing an animated entity, for example, with sunglasses. *See* Office Action, p. 14; *see Ostermann*: col. 11, line 60 – col. 12, line 8.

Ostermann does not cure the deficiencies of *Liles* and *Tang* with respect to independent claim 1. For example, *Ostermann* does not disclose or suggest receiving, independently of a user and communicated message, out-of-band information indicating that the user is in a sunny location or is wearing sunglasses and then accessorizing the animated entity with sunglasses to communicate the out-of-band information based on stored data associations. Moreover, no basis has been established for concluding that it would have been obvious to a skilled artisan to bridge the gap between the applied references and Applicants' claims. Accordingly, *Liles, Tang* and *Ostermann*—whether taken alone or in any combination—fail to render obvious claim 1 or its dependent claims 44-46. Applicants therefore request withdrawal of the section 103 rejection and the timely allowance of dependent claims 44-46.

New claims 85 and 86

Each of new claims 85 and 86 depends upon claim 1 and is similarly not anticipated or rendered obvious by the applied art. Applicants accordingly request the timely allowance of new claims 85 and 86.

Conclusion

Applicants request the Examiner's reconsideration of the application in view of the foregoing and the timely allowance of pending claims 1-68 and 71-86.

It is believed that all pending issues in the outstanding Office Action have been addressed by this paper. The Office Action, however, contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action. In addition, there may be reasons for patentability of any or all pending or other claims that have not been expressed above.

If there are any questions regarding this paper or the application generally, Applicants would appreciate a telephone call to the undersigned since this may expedite prosecution of the application.

The RCE fee of $810 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please grant any extensions of time required to enter this paper and apply any other required charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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